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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,643	07/27/2004	Domenic Belcastro	BEL 0116 PUS	4642

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EXAMINER

BRADEN, SHAWN M

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/710,643	Applicant(s) BELCASTRO, DOMENIC	
	Examiner Shawn M. Braden	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/11/05, 07/29/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Claims 1,2,3,13 are generic to the following disclosed patentably distinct species:

Species 1: Fig. 1

Species 2: Fig. 2

Species 3: Fig. 3

Species 4: Fig. 4

Species 5: Fig. 5

Species 6: Fig. 6

Species 7: Fig. 7

Species 8: Fig. 8

Species 9: Fig. 9

Species 10: Figs (10,11,12)

2. The species are independent or distinct because the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j). Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including

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any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

3. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a). Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with R. Scott Vincent on 5/12/2006 a provisional election was made without traverse to prosecute the invention of species 10, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. No claims withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the cup and lid members in claims 11,20,21 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc. Applicant's abstract is over the 150 word limit.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claim 5 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant fails to clearly define what structure a duck valve recites.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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10. Claims 1,2,5,6,7,9,-13,15,16,18,19,12 are rejected under 35 U.S.C. 102(b) as being anticipated by Morifuji (USPN 5,101,991).

11. With respect to claim 1, Morifuji shows a diaphragm comprising a body (8), a spout (10) portion integrally formed in the body, and a valve portion (12) integrally formed in the body (8) within the spout (10) portion, wherein the body (8) comprises an outward surface, an inward surface, and a peripheral edge delineating the outward surface from the inward surface, wherein the spout (10) portion and the valve portion (12) form a cavity within the inward surface and a drinking opening within the outward surface of the spout (10) portion, whereby fluid may pass from the cavity to the drinking opening through the valve portion (12) when the valve portion (12) is forcibly actuated by the spout (10) portion in response to an externally applied force.

12. With respect to claim 2, to the same extent as claimed Morifuji discloses the diaphragm is made from a flexible material (col. 2 ln. 56).

13. With respect to claim 5, to the same extent as claimed Morifuji shows a duck valve (fig. 6).

14. With respect to claim 6, Morifuji shows a pair of opposing flap portions, wherein each flap portion has edges, and the pair of flap portions (12) are two outer axial edges adjoined along opposite adjacent outer axial edges, whereby the pair of flap portions of the valve portion (12) are normally closed (fig. 1A).

15. With respect to claim 7, to the same extent as claimed by applicant Morifuji shows the valve portion (12) is pyramidal (fig. 6).

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16. With respect to claim 9, Morifuji shows the diaphragm further comprises a vent (18) portion.

17. With respect to claim 10, Morifuji shows a groove (between elements (16,20)) circumferentially formed in the peripheral edge, whereby the groove may engage a drinking cup or a lid portion.

18. With respect to claim 11, Morifuji shows a bottle (1) which meets applicants claimed structure for a drinking cup coupled to the diaphragm.

19. With respect to claim 12, Morifuji shows a drinking cup (1) and a lid (4) portion coupled to the diaphragm.

20. With respect to claim 13, Morifuji shows a body, a spout (10) portion integrally formed in the body, and a valve portion (12) integrally formed in the body (8) within the spout (10) portion, wherein the body (8) comprises an outward surface, an inward surface, and a edge delineating the outward surface from the inward surface, wherein the spout (10) portion outwardly extends from the outward surface forming a cavity within the inward surface and a drinking opening within the outward surface of the spout (10) portion, whereby fluid may pass from the cavity to the drinking opening through the valve portion (12) when the valve portion (12) is forcibly actuated by the spout (10) portion in response to an externally applied force.

21. With respect to claim 15, Morifuji shows the valve portion (12) is comprised of a pair of opposing flap portions (fig. 1A), wherein each flap portion has two outer axial edges, and the pair of flap portions are adjoined along opposite adjacent outer axial edges, whereby the pair of flap portions of the valve portion (12) are normally closed.

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22. With respect to claim 16, to the same extent as claimed by applicant Morifuji shows the valve portion (12) is pyramidal (fig. 6).

23. With respect to claim 18, Morifuji shows the diaphragm further comprises a vent (18) portion.

24. With respect to claim 19, Morifuji shows a groove (between elements (16,20)) circumferentially formed in the peripheral edge, whereby the groove may engage a drinking cup or a lid portion.

25. With respect to claim 12, Morifuji shows a drinking cup (1) and a lid (4) portion coupled to the diaphragm.

26. Claims 1-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Manganiello (USPN 6,607,092).

27. With respect to claim 1, Manganiello shows a diaphragm comprising a body (14), a spout (16) portion integrally formed in the body, and a valve portion (30) integrally formed in the body (14) within the spout (16) portion, wherein the body (14) comprises an outward surface, an inward surface, and a peripheral edge delineating the outward surface from the inward surface, wherein the spout (16) portion and the valve portion (30) form a cavity (17) within the inward surface and a drinking opening within the outward surface of the spout (16) portion, whereby fluid may pass from the cavity (17) to the drinking opening through the valve portion (30) when the valve portion (30) is forcibly actuated by the spout (16) portion in response to an externally applied force.

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28. With respect to claim 2, to the same extent as claimed Manganiello shows a diaphragm is made from a flexible material.

29. With respect to claim 3, Manganiello discloses the flexible material is silicone (Col. 3 ln. 20).

30. With respect to claim 4, Manganiello shows a plurality of web portions (being the tiers or levels of valve portions (30)) axially coupling the valve portion (30) to the spout (16) portion, whereby the valve portion (30) is forcibly actuated by the web portions and the spout (16) portion in response to an externally applied force.

31. With respect to claim 5, to the same extent as claimed Manganiello shows a duck valve (fig. 3).

32. With respect to claim 6, Manganiello shows a pair of opposing flap portions (36), wherein each flap portion (36) has edges, and the pair of flap portions (36) are two outer axial adjoining along opposite adjacent outer axial edges, whereby the pair of flap portions (36) of the valve portion (30) are normally closed.

33. With respect to claim 7, to the same extent as claimed Manganiello shows the valve portion (30) is pyramidal (fig. 3).

34. With respect to claim 8, Manganiello shows the spout (16) portion is elliptical (fig. 5).

With respect to claim 9, Manganiello shows the diaphragm further comprises a vent (18) portion.

Claim Rejections - 35 USC § 103

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35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Morifuji.

Morifuji discloses the invention substantially as claimed. However Morifuji does not disclose material is silicone or latex.

It is common knowledge in the prior art to make spouts out of silicone or latex in the same field of endeavor for the purpose of having a resilient mouth piece.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use silicone or latex in order to have a mouth piece that is hypoallergenic.

It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

36. Claims 8&17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morifuji.

Morifuji discloses the invention substantially as claimed. However Morifuji does not disclose the spout portion is elliptical.

It is common knowledge in the prior art to make the spouts elliptical the same field of endeavor for the purpose of having a more comfortable mouth piece.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the spout portion elliptical in order to have a mouth piece that is more comfortable.

A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Claims 14 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morifuji in view of McInnes (USPN 5,598,809).

Morifuji discloses the invention substantially as claimed. However Morifuji does not disclose a plurality of web portion axially coupling the valve portion to the spout portion.

McInnes teaches a plurality of web portion (15) axially coupling the valve portion to the spout portion in the same field of endeavor for the purpose of controlling flow rates (col. 2 ln. 65-68).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the web portions of McInnes to the spout of Morifuji in order to control the flow rate of fluid dispensed to the user.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawn M. Braden whose telephone number is (571)272-8026. The examiner can normally be reached on Mon-Thurs 8-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on 571 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JES F. PASCUA
PRIMARY EXAMINER

smb